REMARKS

This Request for Reconsideration is filed in response to the Office Action of 19 July 2007. In this Request for Reconsideration, no claims have been amended, added, or canceled. The Applicants respectfully request reconsideration of the application based on the reasons provided herein.

In the Office Action of 19 July 2007, the Examiner rejected claims of the patent application under 35 U.S.C. § 103(a) as being unpatentable over McElwain et al. (U.S. Patent Application Publication No. 2003/0022689A1) in view of Hicks et al. (U.S. Patent No. 7,027,813 A1), and in further view of Makela et al. (U.S. Patent No. 7,099,687). In response, the Applicants respectfully disagree with the rejections and submit that all pending claims are allowable over the prior art of record for at least the following reasons.

For a proper rejection under 35 U.S.C. § 103(a), the prior art in combination must teach or suggest each and every limitation of the claims. In addition, there must be some adequate reasoning to combine the teachings of different references.

1. THE FINALITY OF THE OFFICE ACTION OF 19 JULY 2007 IS IMPROPER SINCE THE EXAMINER'S NEW GROUNDS OF REJECTION BASED ON NEWLY CITED ART WERE NOT NECESSITATED BY THE APPLICANT'S AMENDMENTS.

The Examiner indicates that the present Office Action of 19 July 2007 is final. On page 10 of the Office Action, the Examiner states that the "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a)."

MPEP § 706.07(a) states that

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims...
>
> Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. (Emphasis Added)

In the previously-submitted Amendment and Request for Reconsideration of 27 October 2007, the Applicants amended independent claims 1 and 10 but did not amend independent claims 19 and 21 since the previous Office Action of 11 August 2006 failed to address all claim limitations. The present Office Action of 19 July 2007 includes a rejection based on newly cited art (e.g. Makela et al.), and is made final even though independent claims 19 and 21 were not previously amended by the Applicants.

Thus, the finality of the Office Action of 19 July 2007 is improper, and the Applicants respectfully request for such finality to be withdrawn.

2. THE PRIOR ART IN COMBINATION FAILS TO TEACH OR SUGGEST THE STEP OF RECEIVING AN END USER INPUT TO PERFORM A MANUAL NETWORK SELECTION PROCEDURE AS CLAIMED.

Independent claims 1 and 10 of the present application recite techniques which include "receiving, through a user interface of the mobile station, an end user input to perform a manual network selection procedure" (e.g. see independent method claim 1). In the Office Action, the Examiner states that "McElwain teaches ... receiving through a user interface of the mobile station an end user input to perform a manual network selection procedure (0054)."

In the passage referenced by the Examiner (i.e. paragraph 0054 of McElwain et al.), it is stated that

> Further in accordance with these teachings the mobile station 10 may provide a visual or other display to the user to inform the user of the current service provider status. This can be done by displaying an alphatag, as shown by the following pseudo-code:
>
> ```
> ------------------------------------------------
> /* giving category information to the UI based on
> what alphatag is shown by UI
> (names here are CS specific, UI uses own naming
> convention*/
> .UI_NOT_ROAMING /* Home */
> .UI_NOT_ROAMING_PREPAID /* Cousin */
> .UI_NOT_ROAMING_HOME_TYPE /* Partner */
> .UI_ROAMING_SEMI_NON_HOME_TYPE /* Favored */
> .UI_ROAMING_NON_HOME_TYPE /* Neutral */
> ------------------------------------------------
> ```

As apparent from the above, there is no receipt of any end user input to perform a manual network selection procedure through a user interface. The above relates to the display of an alphatag of the current service provider, which is irrelevant to the claimed step of receiving. Thus, the Examiner's findings fail.

In McElwain et al., a conventional method for roaming control which is referred to as a "Preferred System Selection" is described. The Preferred System Selection technique relates to an *automatic network selection procedure*, where *selection preferences* may be established by the end user. Just because McElwain et al. states that "the user typically controls the system preference and mode operation through menu choice or selection" does not mean that such technique is a manual network selection procedure. As one ordinarily skilled in the art would readily appreciate, in a manual network selection procedure, the user is able to manually select a desired network from a list of available networks which are visually displayed by the mobile station. In response to an end user manual selection of the desired network, the mobile station registers with the selected network. In accordance with the claimed invention, this entire procedure is prompted by the end user as recited in the step of "receiving, through a user interface of the mobile station, an end user input to perform a manual network selection procedure."

The prior art of record, including McElwain et al., Hicks et al. and Makela et al., do not teach or suggestion these limitations. If the Examiner is making any inherency arguments, the Examiner has failed to establish a prima facie case under 35 U.S.C. § 103(a) since any inherent teachings must necessarily be present in the prior art and the Examiner must articulate reasoning related to the same. The Applicant respectfully submits that such teachings as claimed are not present in the prior art of record.

Near the end of the Office Action, the Examiner asserts with respect to all rejections that

> The references made herein are done so for the convenience of the applicant. They are in no way meant to limit the reference. The reference must be considered in its entirety.

In response, the Applicants respectfully note that the Examiner has a duty to articulate claim rejections with specificity and adequate reasoning. Otherwise, the rejection fails. It is difficult if not impossible for the Applicants to adequately respond to a vague and unclear rejection of claims. This is especially true in the present case where the

Examiner is incorporating the disparate teachings of three (3) different references in an obviousness rejection. Further, if the Examiner is making any inherency arguments, any inherent teachings must necessarily be present in the prior art and the Examiner must articulate reasoning related to the same.

Based on the above, the Applicants respectfully request the Examiner to withdraw the improper claim rejections and allow the application.

3. THE PRIOR ART IN COMBINATION FAILS TO TEACH OR SUGGEST THE STEP OF RETRIEVING A PLURALITY OF NETWORK IDENTIFIERS CORRESPONDING TO THE PLURALITY OF IDENTIFIED COMMUNICATION NETWORKS IN ACCORDANCE WITH AN ENHANCED OPERATOR NAME STRING (EONS) PROTOCOL AS CLAIMED.

All claims of the present application recite a technique which includes "retrieving a plurality of network identifiers corresponding to the plurality of identified communication networks in accordance with an Enhanced Operator Name String (EONS) protocol" (see e.g. claim 1) or the like. In the rejection of claims, the Examiner states that "McElwain teaches ... retrieving a plurality of network identifiers corresponding to the plurality of identified communication networks (0054)." In addition, the Examiner states that "McElwain fails teach retrieving a plurality of network identifiers corresponding to the plurality of communication networks in accordance with an Enhanced Operator Name String (EONS) protocol. However, Hicks teaches retrieving a plurality of network identifiers corresponding to the plurality of communication networks in accordance with an Enhanced Operator Name String (EONS) protocol (col 1 lines 64-67, col 2 lines 1-10)."

In the passage of McElwain et al. referenced by the Examiner (i.e. paragraph 0054 of McElwain et al.), it is stated that

> Further in accordance with these teachings the mobile station 10 may provide a visual or other display to the user to inform the user of the current service provider status. This can be done by displaying an alphatag, as shown by the following pseudo-code:
>
> ```
> ------------------------------------------------
> /* giving category information to the UI based on
> what alphatag is shown by UI
> (names here are CS specific, UI uses own naming
> convention*/
> .UI_NOT_ROAMING /* Home */
> .UI_NOT_ROAMING_PREPAID /* Cousin */
> ```

```
.UI_NOT_ROAMING_HOME_TYPE /* Partner */
.UI_ROAMING_SEMI_NON_HOME_TYPE /* Favored */
.UI_ROAMING_NON_HOME_TYPE /* Neutral */
-------------------------------------------------
```

As indicated above, it is stated that "mobile station 10 may provide a visual or other display to inform the user of the *current service provider status*." However, this does not teach a plurality of network identifiers that are retrieved based on a plurality of scanned and available networks. Rather, this teaching relates to a single network identifier that is retrieved merely for a single *currently registered network*. The claimed step is not even performed in, during, or for any manual network selection procedure.

As apparent, although the patent publication of McElwain et al. happens to visually illustrate a plurality of category types based on what alphatag is shown by the user interface, the mobile terminal of McElwain et al. does not retrieve the plurality of category types for multiple networks identified from a scanning process; rather it merely utilizes the category information for retrieving a single network identification (i.e. the currently registered network).

The Hicks et al. reference fails to make up for such deficiency. The passage in Hicks et al. that the Examiner refers to relates to the conventional usage of EONS. In column 2 at lines 3-6, for example, Hicks et al. states that

> The E-ONS feature is intended to provide an algorithm for determining what to display on the mobile's display with respect to the current service provider information via an alphanumeric tag on the mobile user interface. (Emphasis Added)

Thus, Hicks et al. fails for the same reasons as the McElwain et al. reference with respect to the step of "retrieving a plurality of network identifiers corresponding to the plurality of identified communication networks in accordance with an Enhanced Operator Name String (EONS) protocol" (see e.g. claim 1).

Near the end of the Office Action, the Examiner asserts with respect to all rejections that

> The references made herein are done so for the convenience of the applicant. They are in no way meant to limit the reference. The reference must be considered in its entirety.

In response, the Applicants respectfully note that the Examiner has a duty to articulate claim rejections with specificity and adequate reasoning. Otherwise, the rejection fails. It is difficult if not impossible for any Applicant to adequately respond to a vague and unclear rejection of claims. This is especially true in the present case where the Examiner is incorporating the disparate teachings of three (3) different references in an obviousness rejection. Further, if the Examiner is making any inherency arguments, any inherent teachings must necessarily be present in the prior art and the Examiner must articulate reasoning related to the same.

Based on the above, the Applicants respectfully request the Examiner to withdraw the improper claim rejections and allow the application.

4. THE PRIOR ART IN COMBINATION FAILS TO TEACH OR SUGGEST THE STEP OF VISUALLY DISPLAYING THE PLURALITY OF NETWORK IDENTIFIERS RETRIEVED IN ACCORDANCE WITH THE EONS PROTOCOL.

All claims of the present application recite a technique which includes "visually displaying the plurality of network identifiers retrieved" which occurs "in the manual network selection procedure" (see e.g. claim 1) or the like. In independent claims 19 and 21, for example, the technique includes "simultaneously visually displaying the plurality of network identifiers."

In the Office Action, the Examiner states that "McElwain teaches ... visual displaying the plurality of network identifiers retrieved (0054)." In the passage referenced by the Examiner (i.e. paragraph 0054 of McElwain et al.), it is stated that

> Further in accordance with these teachings the mobile station 10 may provide a visual or other display to the user to inform the user of the current service provider status. This can be done by displaying an alphatag, as shown by the following pseudo-code:
>
> ```
> ------------------------------------------------
> /* giving category information to the UI based on
> what alphatag is shown by UI
> (names here are CS specific, UI uses own naming
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> .UI_NOT_ROAMING /* Home */
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> .UI_NOT_ROAMING_HOME_TYPE /* Partner */
> .UI_ROAMING_SEMI_NON_HOME_TYPE /* Favored */
> .UI_ROAMING_NON_HOME_TYPE /* Neutral */
> ------------------------------------------------
> ```

As indicated above, it is stated that "mobile station 10 may provide a visual or other display to inform the user of the *current service provider status*." However, this does not teach a plurality of network identifiers that are visually displayed based on the scanned available networks for a manual network selection procedure. Rather, this teaching

relates to the network identifier that is displayed merely for a single *currently registered network*. The claimed step is not even performed in, during, or for any manual network selection procedure.

As apparent, although the patent publication of McElwain et al. happens to visually illustrate a plurality of category types based on what alphatag is shown by the user interface, the mobile terminal of McElwain et al. does not visually display the plurality of category types for multiple networks simultaneously; rather, it merely utilizes the plurality of category types for displaying a single network identification at a time (i.e. the currently registered network). Thus, the Examiner's findings fail.

Relatedly, the Examiner utilizes the Makela et al. reference for allegedly teaching "a user manual network selection (col 10 lines 12-67, col 11 lines 1-5)." In the passage referenced by the Examiner, in column 10 at lines 63-66, it is stated that "[i]t may form a message to be shown on the display of the mobile terminal to inform the user about the suggested bearer service, or possibly a list of bearer services that may be selected." This display of the list in Makela et al. does not, however, teach, suggest, or render obvious the step of "visually displaying the plurality of network identifiers retrieved." For one, the display of the "list of bearer services that may be selected" is a list based on a bearer service reply network message received from the network – not from networks identified from scanning. Note that it is not even explicit in Makela et al. where any scanning is performed to identify available networks. Further, the display of the "list of bearer services that may be selected" of Makela et al. is far removed from the actual fully-claimed step of "visually displaying the plurality of network identifiers retrieved in accordance with the EONS protocol" (e.g. see claim 1). For example, it has not been demonstrated, articulated, or reasoned why the teachings of Hicks et al. (i.e. the teachings of EONS) would be incorporated with the teachings of Makela et al. (as opposed to McElwain et al.).

Near the end of the Office Action, the Examiner asserts with respect to all rejections that

> The references made herein are done so for the convenience of the applicant. They are in no way meant to limit the reference. The reference must be considered in its entirety.

In response, the Applicants respectfully note that the Examiner has a duty to articulate claim rejections with specificity and adequate reasoning. Otherwise, the rejection fails. It is difficult if not impossible for any Applicant to adequately respond to a vague and unclear rejection of claims. This is especially true in the present case where the Examiner is incorporating the disparate teachings of three (3) different references in an obviousness rejection. Further, if the Examiner is making any inherency arguments, any inherent teachings must necessarily be present in the prior art and the Examiner must articulate reasoning related to the same.

Based on the above, the Applicants respectfully request the Examiner to withdraw the improper claim rejections and allow the application.

5. THE PRIOR ART IN COMBINATION FAILS TO TEACH ONE OR MORE OF THE CLAIMED STEPS WHICH OCCUR IN OR DURING A MANUAL NETWORK SELECTION PROCEDURE.

Claims of the present application recite that particular steps occur "in" or "during" a manual network selection procedure. In independent method claim 1, for example, it is recited that the steps of "scanning," "retrieving," "visually displaying," and "receiving" occur "in the manual network selection procedure." Deliberate use of a *colon ":"* is provided after the limitation "in the manual network selection procedure," and the subsequently claimed steps fall within the scope of this procedure through deliberate use of *indentation* of these steps. If the Examiner is broadly interpreting the claim language in a different manner, then the Examiner's interpretation is unreasonable. Independent claims 10, 19, and 21 are worded and structured differently from claim 1, but the same or similar interpretation principles apply.

The prior art fails to teach that one or more of these steps occur in or during a manual network selection procedure, especially one that is triggered by receipt of an end user input to perform the procedure (e.g. see claims 1 and 10). For example, the Examiner asserts that the McElwain et al. reference teaches or suggests the step of "scanning" and, even assuming *arguendo* that it does, this step of scanning does not occur in or during any manual network selection procedure. As another example, the Examiner asserts that the Hicks et al. reference teaches or suggests the step of "retrieving" and, even assuming *arguendo* that it does, this step of retrieving does not occur in or during any manual network selection procedure even when the teachings of McElwain et al. and Hicks et al. are combined.

Thus, the Applicants respectfully request the Examiner to withdraw the improper claim rejections and allow the application.

Based on the reasons presented herein, the Applicants respectfully request the Examiner to withdraw all § 103 rejections and allow all pending claims 1-24. The Applicants respectfully submit that the present application is now in a condition suitable for allowance based on the reasons presented herein.

Thank you. The Examiner is welcome to contact the undersigned if necessary to expedite prosecution of the present application.

Respectfully submitted,

/John J. Oskorep/

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